ESTTA Tracking number:

ESTTA711251

Filing date:

11/28/2015

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91218523
Party	Plaintiff Oakhurst Industries, Inc. DBA Freund Baking Co.
Correspondence Address	STEVEN A. FREUND Law Office of Steven A. Freund P.O. BOX 911457 LOS ANGELES, CA 90091 UNITED STATES sfreund@freundlawfirm.com
Submission	Motion to Amend Pleading/Amended Pleading
Filer's Name	Steven Freund
Filer's e-mail	sfreund@freundlawfirm.com
Signature	/Steven Freund/
Date	11/28/2015
Attachments	15.11.28.Motion.To.Amend.pdf(534318 bytes) 15.11.28.First.Amended.Notice.of.Opposition.Redline.pdf(274478 bytes) 15.11.28.First.Amended.Notice.of.Opposition.pdf(125888 bytes) Exhibit.A.to.First.Amended.Ntc.Opposition.pdf(4051061 bytes)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

OAKHURST INDUSTRIES, INC. DBA FREUND) Opposition No. 91218523
BAKING CO.,)
Opposer,) Application Serial No. 86/139,432
) Mark: FREUND'S FAMOUS
) Filing Date: December 10, 2013
v.) Application Serial No. 86/139,577
) Mark: Freunds
) Filing Date: December 10, 2013
)
13TH AVE FISH MARKET INC. DBA FREUND'S)
FISH,)
Applicant)
50A-9	1

OPPOSER OAKHURST INDUSTRIES, INC. DBA FREUND BAKING CO.'S MOTION FOR LEAVE TO AMEND NOTICE OF OPPOSITION TO WITHDRAW DILUTION CLAIM

Pursuant to Fed. R. Civ. P. 15(a) and Trademark Trial and Appeal Board Manual of Procedure, Oakhurst Industries, Inc. DBA Freund Baking Co. ("Opposer") hereby requests leave to amend its Notice of Opposition to withdraw its dilution claim as grounds for opposition of Application Serial No. 86/139,432 for the word mark FREUND'S FAMOUS and Application Serial No. 86/139,577 for the words and design mark (literal element FREUND'S FAMOUS).

ARGUMENT

A. The Board Should Allow Opposer To Dismiss With Prejudice Its Dilution Claim Under Fed. R. Civ. P. 15(a) And Trademark Rule 2.106 (c).

Where plaintiff wants to drop certain claims but not to dismiss any defendant, the proper procedure is to amend the complaint ((Fed. R. Civ. P. 15(a); Ethridge v. Harbor House Restaurant (9th Cir. 1988) 861 F2d 1389, 1392.)

Rule 37 C.F.R. §2.106(c) provides that if a party to an opposition proceeding withdraws its opposition without consent at any time after an Answer has been filed, then the withdrawal will be with prejudice. This rule contemplates that the Opposer should be

allowed to withdraw its opposition at any time if it is willing to accept that its claims will be dismissed with prejudice. The rule, however, does not clearly indicate whether it applies only to the withdrawal of opposition as a whole, or whether certain claims within the opposition may be withdrawn with prejudice at any time after an Answer has been filed. However, in light of the above authority regarding Fed. R. Civ. P. 15(a) and the judicial policy favoring dismissal unless defendant will suffer "some plain legal prejudice" as a result of the dismissal, dismissing Opposer's dilution claim with prejudice is proper. (9th Cir. 1982) *Hamilton v. Firestone Tire & Rubber Co., Inc.* 679 F2d 143, 145.

Opposer could not locate any case law directly on point. However, allowing a party to drop some of its claims with prejudice (at a minimum) would be consistent with the purpose of a rule that allows a party to withdraw all of its claims (e.g., the entire opposition) with prejudice. In both cases, the party would be precluded from asserting the same claims again against the same application.

The Board should allow Opposer to withdraw its dilution claim with prejudice since any possibility of prejudice to Applicant would be mitigated by the fact that Opposer would not be able to reassert these claims against Applicant relating to Application Serial Nos. 86/139,432 and 86/139,577.

In summary, judicial economy, the interest of justice and the lack of any prejudice to Applicant require granting the instant Motion to Amend to withdraw Opposer's dilution claim with prejudice. Pursuant to TBMP §507.01, Opposer has attached redline and clean versions showing the proposed amendments to the Notice of Opposition. Opposer notes that the amendments reflect deletion of Opposer's fraud claim, which was stricken by the Board's order on March 6, 2015. (Dkt. entry no. 12.)

II. <u>CONCLUSION</u>

For all the foregoing reasons, it would be appropriate to grant this Motion.

Respectfully Submitted,

Dated: November 28, 2015

Steven A. Freund Esq.

Attorney for Opposer Law Office of Steven A. Freund A Professional Corporation

P.O. Box 911457

Los Angeles, CA 90091 Phone: 310-284-7929

PROOF OF SERVICE

I hereby certify that true and complete copies of the foregoing OPPOSER OAKHURST INDUSTRIES, INC. DBA FREUND BAKING CO.'S MOTION FOR LEAVE TO AMEND NOTICE OF OPPOSITION TO WITHDRAW DILUTION CLAIM and PROPOSED FIRST AMENDED NOTICE OF OPPOSITION have been served on Applicant's counsel via First Class U.S. Mail on November 28, 2015, postage prepaid to:

Robert B.G. Horowitz Baker & Hostetler LLP 45 Rockefeller Plaza, 14th Floor New York, New York 10111-0100

Lesley McCall Grossberg Baker & Hostetler LLP 2929 Arch Street Cira Centre, 12th Floor Philadelphia, PA 19104-2891

Steven A. Freund, Esq

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

OAKHURST INDUSTRIES, INC. DBA FREUND) Opposition No. <u>91218523</u>
BAKING CO.,)
Opposer,) Application Serial No. 86/139,432
• •) Mark: FREUND'S FAMOUS
) Filing Date: December 10, 2013
)
٧.) Application Serial No. 86/139,577
) Mark: Freunds
) Filing Date: December 10, 2013
)
13 TH AVE FISH MARKET INC. DBA FREUND'S)
FISH,)
,)
Applicant)

FIRST AMENDED NOTICE OF OPPOSITION

Oakhurst Industries, Inc. DBA Freund Baking Co. ("Opposer"), a California corporation with its address at 2050 South Tubeway Ave., Commerce, CA 90040, believes that it will be damaged by registration of Application Serial No. 86/139,432 for the word mark FREUND'S FAMOUS and Application Serial No. 86/139,577 for the words and design mark (literal element FREUND'S FAMOUS) (both of the foregoing marks individually referred to by their Application Serial Numbers and collectively as "Applicant's Marks"), both as applied for in the above-identified applications on December 10, 2013 by 13th Ave Fish Market Inc. DBA Freund's Fish¹ ("Applicant"), a New York corporation with its address at 4301 15th Avenue, Brooklyn NY 11219, and therefore, hereby opposes registration Applicant's Marks.

As grounds for opposition, Opposer alleges the following:

1. Opposer owns two U.S. Registrations (Reg. No. 4,304,304 and Reg. No.4,500,792) for the words and design mark (literal element SINCE 1856 FREUND

¹ It should be noted that when Opposer's attorney conducted a search through the New York Department of State, Division of Corporations, it was found that Applicant does not have a DBA called "Freund's Fish".

BAKING CO.) as applied for in the above-identified registrations (both of the foregoing marks individually referred to by their Registration Numbers). The registrations together cover the following goods and services: "Bakery products" and "Private label baking services" ("Opposer's Goods and Services"). The registrations are valid, subsisting and in full force and effect. Copies of Opposer's registration certificates and true and correct copies of TSDR printouts showing current status and title for Opposer's registrations are attached hereto as Exhibit A, and are incorporated by reference as though fully set forth herein.

- 2. Opposer's Reg. No. 4,500,792 has "SINCE 1856" and "BAKING CO." disclaimed.
- 3. In addition, Opposer owns common law rights in the words and design mark that is the subject of Opposer's Reg. Nos. 4,304,304 and 4,500,792 for Opposer's Goods and Services. Opposer further owns common law rights for marks that are different colored versions of Opposer's Reg. Nos. 4,304,304 and 4,500,792 for Opposer's Goods and Services, such as . Moreover, Opposer owns common law rights in the word mark FREUND BAKING CO. for Opposer's Goods and Services. All of Opposer's marks that feature the term FREUND are referred to herein as "Opposer's Marks."
- 4. Opposer has invested considerable money, time and effort into the use, advertising and promotion of Opposer's Marks in connection with Opposer's Goods and Services.
- 5. Opposer has been using Opposer's Marks in connection with Opposer's Goods and Services since at least as early as January 1981.
- 6. Opposer's Marks have a long and illustrious history in connection with Opposer's Goods and Services going back many years.
- 7. Since long prior to Applicant's filing date and Applicant's alleged first use and first use in commerce date of Applicant's Marks, Opposer has continuously and extensively used in interstate commerce Opposer's Marks on and in connection with the advertising, promotion, offer and sale of Opposer's Goods and Services.

- 8. Opposer filed its application for the registration that matured into Reg. No. 4,304,304 on May 16, 2012 and also filed its application for the registration that matured into 4,500,792 on May 30, 2013.
 - 9. Opposer's Marks are inherently distinctive.
- 10. Opposer's Marks are highly distinctive with regards to the goods and services covered in Opposer's Goods and Services. Moreover, Opposer's Marks are highly distinctive with regards to the food industry. Opposer's Marks have earned tremendous goodwill in the food industry. Through Opposer's widespread use of Opposer's Marks and Opposer's Goods and Services, extensive promotion of Opposer's Marks and Opposer's Goods and Services, customer recognition of Opposer's Marks and Opposer's Goods and Services, Opposer's loyal customer base, its multiple trademark registrations, and other factors, Opposer's Marks have become famous within the meaning of Section 43(c) of the United States Trademark Act, 15 U.S.C. § 1125(c).
- 11. Notwithstanding Opposer's prior rights in and to Opposer's Marks, Applicant filed on December 10, 2013 the above-identified applications for Applicant's Marks both for: "GEFILTE FISH, FRESH FISH, NOT LIVE, FROZEN FISH, CANNED TUNA FISH, AND BREADED FISH FILLETS" ("Applicant's Goods"), both with a claimed first use and first use in commerce date of October 1, 2013.

FIRST GROUND FOR OPPOSITION: PRIORITY AND LIKELIHOOD OF CONFUSION

- 12. Opposer incorporates by reference Paragraphs 1 through 11, inclusive, as if fully set forth herein.
- 13. Opposer filed its applications for its marks previous to Applicant's filing date for Applicant's Marks. Both of Opposer's filing dates cited in Paragraph 8 are previous to Applicant's claimed first use and first use in commerce dates for Applicant's Marks.
- 14. Opposer has priority over Applicant through the use of Opposer's Marks previous to the filing date of Applicant's Marks and through Opposer's Reg. No. 4,304,304 and Reg. No. 4,500,792.

- 15. Applicant is not affiliated or connected with Opposer, nor has Opposer endorsed or sponsored Applicant.
 - 16. Applicant's Marks both have "FAMOUS" disclaimed.
- 17. Opposer's Marks and Applicant's Marks all incorporate the word "FREUND".
- 18. Because of the disclaimer for Applicant's Marks, and Applicant's Marks' "S" merely denoting non-distinctive matter signifying the possessive, "FREUND" should be considered the dominant part of Applicant's Marks.
- 19. Since in Opposer's Reg. No. 4,500,792 all the words other than "FREUND" are disclaimed and in Opposer's Reg. Nos. 4,500,792 and 4,304,304 "FREUND" appears in the largest letters and in the center, most prominent portion of both registrations (along with the common law version of such marks) "FREUND" should be considered the dominant part of Opposer's Reg. Nos. 4,500,792 and 4,304,304, along with the common law versions of such marks.
- 20. Moreover, "FREUND" should be considered the dominant part of Opposer's common law mark for the words mark SINCE 1856 FREUND BAKING CO. Opposer's common law mark for FREUND BAKING CO. and Opposer's common law mark
- 21. The design element of Opposer's Marks incorporates the word "Freund" in white stylized lettering, with the "F" in "Freund" capitalized and the rest of the word in lower case letters all against a blue background. The "F" in Opposer's Marks has its ends cut diagonally at a 45 degree angle and not in a vertical direction.
- 22. Applicant's Serial No. 86/139,577 is confusingly similar in appearance and commercial impression to Opposer's Marks because it too incorporates the word "Freund" in white stylized lettering in a highly similar font to the one Opposer's Marks have, with the "F" in "Freund" capitalized and the rest of the word in lower case letters all against a blue background and the "F" in Applicant's Serial No. 86/139,577 also has its ends cut diagonally at a 45 degree angle and not in a vertical direction.

- 23. Since Opposer's Marks and Applicant's Marks both have the shared identical wording of "FREUND", since "FREUND" is the dominant part of Opposer's Marks and Applicant's Marks and since Opposer's Marks and Applicant's Serial No. 86/139,577 have similar design components, Applicant's Marks are confusingly similar in appearance and commercial impression to Opposer's Marks.
- 24. Though different foods and food-related services may fall into different classes, such as Applicant's and Opposer's, such foods and food-related services can be considered closely related for a likelihood of confusion analysis, especially when the foods and food-related services are complimentary.
- 25. Opposer's Goods and Services and Applicant's Goods should be considered closely related and complimentary, especially because Applicant's Goods, namely its breaded fish fillets, incorporate bread, which is a part of Opposer's Goods and Services.
- 26. Moreover, Applicant has already produced and sold products that incorporate bread and bakery products similar or the same as Opposer's Goods and Services under the same marks that comprise Applicant's Marks alongside and separate from Applicant's Goods, such as tempura batter mix, muffins, cakes and cookies. This shows that Applicant has already expanded into Opposer's Goods and Services, which would cause people to be confused as to source between Opposer and Applicant. Were Applicant to release further bread and bakery products under Applicant's Marks, this likelihood of confusion would continue, due to Applicant's expansion into Opposer's Goods and Services.
- 27. The consolidation and diversification of food manufacturing companies often leads to different types of food products being distributed by one company, with most consumers not being aware of this. Thus, when viewing Applicant's Marks in connection with Applicant's Goods, consumers are likely to be confused into believing that such goods originate with, are approved, sponsored or endorsed by, or have some connection or affiliation with Opposer.

- 28. Moreover, Opposer's Goods and Services and Applicant's Goods are complimentary because Opposer's bakery products and Applicant's fish products are often combined for dishes such as sandwiches.
- 29. Opposer's Goods and Applicant's Goods have similar trade channels because they both incorporate products that are found in the same places.
- 30. Opposer's Goods and Applicant's Goods are offered to similar or overlapping classes of purchasers.
- 31. Applicant's Marks, when used in connection with Applicant's Goods and Applicant's bread and bakery products is likely to cause confusion, to cause mistake, and to deceive the trade and public, who, upon seeing the Applicant's Marks in connection with Applicant's Goods and Applicant's bread and bakery products, would believe that such goods originate with, are approved, sponsored or endorsed by, or have some connection or affiliation with Opposer. Accordingly, registration of Applicant's Marks would damage Opposer, and registration, therefore, should be refused pursuant to Section 2(d) of the Trademark Act.

SECOND GROUND FOR OPPOSITION:

DILUTION OF FAMOUS MARKS

- 32. Opposer incorporates by reference Paragraphs 1 through 31, inclusive, as if fully set forth herein.
- 33. Opposer's Marks are famous as defined under Section 43(c)(1) of the Trademark Act, through Opposer's extensive use and promotion of Opposer's Marks in connection with Opposer's Goods and Services.
- 34. Opposer's Marks are also famous in food industry.
- 35. Opposer's Marks became famous before Applicant's filing date and Applicant's alleged first use and first use in commerce dates for Applicant's Marks.
- 36. Opposer has continuously used Opposer's Marks throughout the United States and internationally.
- 37. Applicant's Marks are likely to cause an association between Applicant's Marks and Opposer's Marks. This false association impairs the distinctiveness of

Opposer's Marks and weakens the connection in the public's mind between Opposer's Marks and Opposer's Goods and Services.

38. Applicant's Marks so resemble Opposer's Marks that they are likely to cause dilution by blurring. Accordingly, registration of Applicant's Marks would damage Opposer, and registration, therefore, should be refused pursuant to Section 43(c) of the Trademark Act.

THIRD GROUND FOR OPPOSITION:

MERE DESCRIPTIVENESS - ONLY FOR APPLICATION SERIAL No. 86/139,577

- 3932. Opposer incorporates by reference Paragraphs 1 through 3831 inclusive, as if fully set forth herein.
- 4033. Applicant's Serial No. 86/139,577 incorporates as part of its design element the picture of a fish.
 - 4134. Such a picture of a fish does not have secondary meaning.
- 4235. Applicant's Goods are fish products such as: "GEFILTE FISH, FRESH FISH, NOT LIVE, FROZEN FISH, CANNED TUNA FISH, AND BREADED FISH FILLETS", as listed in the applications for Applicant's Marks.
- 4336. The legally equivalent wording to the picture of a fish part of the design component of Applicant's Serial No. 86/139,577 is "fish".
- 44<u>37</u>. Thus, the picture of a fish part of the design component of Applicant's Serial No. 86/139,577 is merely descriptive of Applicant's Goods. Accordingly, registration of Serial No. 86/139,577, should be refused pursuant to Section 2(e)(1) of the Trademark Act.

FOURTH GROUND FOR OPPOSITION: FRAUD

- 45. Opposer incorporates by reference Paragraphs 1 through 44 inclusive, as if fully set forth herein.
- 46. When Applicant filed its Application Serial No. 86/139,577, it used a drawing of the mark that was subject of that application with a * registration symbol incorporated in that mark.

- 47. When Applicant filed its Application Serial No. 86/139,577 and Application Serial No. 86/139,432, it submitted the same specimen for each application, showing fish products with the drawing as originally submitted with the * registration symbol.
- 48. On March 27, 2014, Applicant received an office action (the "Office Action") from the USPTO for its Application Serial No. 86/139,577 stating, among other issues, that Applicant must submit a new drawing of the mark that is the subject of that application deleting the ® registration symbol. The ® registration symbol may not be used in connection with a mark until it is registered with the USPTO.
- 49. On June 9, 2014, Applicant responded to the Office Action by, inter alia, submitting a new drawing of the mark that was the subject of Application Serial No. 86/139,577 without the ® registration symbol (the "New Drawing"). Applicant did not amend its first use or first use and first use in commerce date for the mark under this application when it submitted the amended drawing.
- 50. Applicant did not use the New Drawing as early as its stated first use and first use in commerce date of October 1, 2013 in its Application Serial No. 86/139,577.
- 51. Applicant knew that it had not used the New Drawing as early as its stated first use and first use in commerce date of October 1, 2013 in its Application Serial No. 86/139.577.
- 52. At least as early as Applicant's receipt of the Office Action, Applicant was on notice that it was improper to submit drawings and specimens for marks with the **
 registration symbol because its marks were not registered.
- 53. Applicant did not inform the USPTO that its specimens for both of Applicant's Marks bore the ® registration symbol.
- 54. Applicant has sold and promoted Applicant's Goods with Applicant's Marks on them using the originally submitted drawing of the mark with the registration symbol.

55. Applicant has continued to sell and promote Applicant's Goods with Applicant's Marks on them using the originally submitted drawing of the mark with the registration symbol.

56. Applicant willfully failed to correct its misrepresentation to the USPTO that its specimens for both of Applicant's Marks contained the ® registration symbol.

57. Applicant willfully failed to correct its misrepresentation to the USPTO that the first use and first use in commerce date as stated in the applications for Applicant's Serial No. 86/139,577 were still not correct.

58. Such willful misrepresentations to the USPTO allowed Applicant's Marks to proceed to publication. Accordingly, registration of Applicant's Marks should be refused due to fraud on the USPTO.

Wherefore, Opposer prays that this Opposition be sustained and that Application Serial No. 86/139,432 and Application Serial No. 86/139,577 be refused registration.

The required fee of six hundred dollars (\$600) is has been previously submitted herewith.

Respectfully Submitted,

/Steven A. Freund/

Dated: November 28, 2015

By: _____

Steven A. Freund, Esq.
Attorney for Opposer
Law Office of Steven A. Freund
A Professional Corporation
P.O. Box 911457
Los Angeles, CA 90091

Phone: 310-284-7929

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

OAKHURST INDUSTRIES, INC. DBA FREUND) Opposition No. 91218523
BAKING CO.,)
Opposer,	 Application Serial No. 86/139,432 Mark: FREUND'S FAMOUS Filing Date: December 10, 2013
V.	 Application Serial No. 86/139,577 Mark: Filing Date: December 10, 2013
13 TH AVE FISH MARKET INC. DBA FREUND'S FISH, Applicant)))

FIRST AMENDED NOTICE OF OPPOSITION

Oakhurst Industries, Inc. DBA Freund Baking Co. ("Opposer"), a California corporation with its address at 2050 South Tubeway Ave., Commerce, CA 90040, believes that it will be damaged by registration of Application Serial No. 86/139,432 for the word mark FREUND'S FAMOUS and Application Serial No. 86/139,577 for the words and design mark (literal element FREUND'S FAMOUS) (both of the foregoing marks individually referred to by their Application Serial Numbers and collectively as "Applicant's Marks"), both as applied for in the above-identified applications on December 10, 2013 by 13th Ave Fish Market Inc. DBA Freund's Fish¹ ("Applicant"), a New York corporation with its address at 4301 15th Avenue, Brooklyn NY 11219, and therefore, hereby opposes registration Applicant's Marks.

As grounds for opposition, Opposer alleges the following:

1. Opposer owns two U.S. Registrations (Reg. No. 4,304,304 and Reg. No. 4,500,792) for the words and design mark (literal element SINCE 1856 FREUND

¹ It should be noted that when Opposer's attorney conducted a search through the New York Department of State, Division of Corporations, it was found that Applicant does not have a DBA called "Freund's Fish".

BAKING CO.) as applied for in the above-identified registrations (both of the foregoing marks individually referred to by their Registration Numbers). The registrations together cover the following goods and services: "Bakery products" and "Private label baking services" ("Opposer's Goods and Services"). The registrations are valid, subsisting and in full force and effect. Copies of Opposer's registration certificates and true and correct copies of TSDR printouts showing current status and title for Opposer's registrations are attached hereto as Exhibit A, and are incorporated by reference as though fully set forth herein.

- 2. Opposer's Reg. No. 4,500,792 has "SINCE 1856" and "BAKING CO." disclaimed.
- 3. In addition, Opposer owns common law rights in the words and design mark that is the subject of Opposer's Reg. Nos. 4,304,304 and 4,500,792 for Opposer's Goods and Services. Opposer further owns common law rights for marks that are different colored versions of Opposer's Reg. Nos. 4,304,304 and 4,500,792 for Opposer's Goods and Services, such as . Moreover, Opposer owns common law rights in the word mark FREUND BAKING CO. for Opposer's Goods and Services. All of Opposer's marks that feature the term FREUND are referred to herein as "Opposer's Marks."
- 4. Opposer has invested considerable money, time and effort into the use, advertising and promotion of Opposer's Marks in connection with Opposer's Goods and Services.
- 5. Opposer has been using Opposer's Marks in connection with Opposer's Goods and Services since at least as early as January 1981.
- 6. Opposer's Marks have a long and illustrious history in connection with Opposer's Goods and Services going back many years.
- 7. Since long prior to Applicant's filing date and Applicant's alleged first use and first use in commerce date of Applicant's Marks, Opposer has continuously and extensively used in interstate commerce Opposer's Marks on and in connection with the advertising, promotion, offer and sale of Opposer's Goods and Services.

- 8. Opposer filed its application for the registration that matured into Reg. No. 4,304,304 on May 16, 2012 and also filed its application for the registration that matured into 4,500,792 on May 30, 2013.
 - 9. Opposer's Marks are inherently distinctive.
- 10. Opposer's Marks are highly distinctive with regards to the goods and services covered in Opposer's Goods and Services. Moreover, Opposer's Marks are highly distinctive with regards to the food industry. Opposer's Marks have earned tremendous goodwill in the food industry.
- 11. Notwithstanding Opposer's prior rights in and to Opposer's Marks, Applicant filed on December 10, 2013 the above-identified applications for Applicant's Marks both for: "GEFILTE FISH, FRESH FISH, NOT LIVE, FROZEN FISH, CANNED TUNA FISH, AND BREADED FISH FILLETS" ("Applicant's Goods"), both with a claimed first use and first use in commerce date of October 1, 2013.

FIRST GROUND FOR OPPOSITION: PRIORITY AND LIKELIHOOD OF CONFUSION

- 12. Opposer incorporates by reference Paragraphs 1 through 11, inclusive, as if fully set forth herein.
- 13. Opposer filed its applications for its marks previous to Applicant's filing date for Applicant's Marks. Both of Opposer's filing dates cited in Paragraph 8 are previous to Applicant's claimed first use and first use in commerce dates for Applicant's Marks.
- 14. Opposer has priority over Applicant through the use of Opposer's Marks previous to the filing date of Applicant's Marks and through Opposer's Reg. No. 4,304,304 and Reg. No. 4,500,792.
- 15. Applicant is not affiliated or connected with Opposer, nor has Opposer endorsed or sponsored Applicant.
 - 16. Applicant's Marks both have "FAMOUS" disclaimed.
- 17. Opposer's Marks and Applicant's Marks all incorporate the word "FREUND".

- 18. Because of the disclaimer for Applicant's Marks, and Applicant's Marks' "'S" merely denoting non-distinctive matter signifying the possessive, "FREUND" should be considered the dominant part of Applicant's Marks.
- 19. Since in Opposer's Reg. No. 4,500,792 all the words other than "FREUND" are disclaimed and in Opposer's Reg. Nos. 4,500,792 and 4,304,304 "FREUND" appears in the largest letters and in the center, most prominent portion of both registrations (along with the common law version of such marks) "FREUND" should be considered the dominant part of Opposer's Reg. Nos. 4,500,792 and 4,304,304, along with the common law versions of such marks.
- 20. Moreover, "FREUND" should be considered the dominant part of Opposer's common law mark for the words mark SINCE 1856 FREUND BAKING CO. Opposer's common law mark for FREUND BAKING CO. and Opposer's common law mark
- 21. The design element of Opposer's Marks incorporates the word "Freund" in white stylized lettering, with the "F" in "Freund" capitalized and the rest of the word in lower case letters all against a blue background. The "F" in Opposer's Marks has its ends cut diagonally at a 45 degree angle and not in a vertical direction.
- 22. Applicant's Serial No. 86/139,577 is confusingly similar in appearance and commercial impression to Opposer's Marks because it too incorporates the word "Freund" in white stylized lettering in a highly similar font to the one Opposer's Marks have, with the "F" in "Freund" capitalized and the rest of the word in lower case letters all against a blue background and the "F" in Applicant's Serial No. 86/139,577 also has its ends cut diagonally at a 45 degree angle and not in a vertical direction.
- 23. Since Opposer's Marks and Applicant's Marks both have the shared identical wording of "FREUND", since "FREUND" is the dominant part of Opposer's Marks and Applicant's Marks and since Opposer's Marks and Applicant's Serial No. 86/139,577 have similar design components, Applicant's Marks are confusingly similar in appearance and commercial impression to Opposer's Marks.

- 24. Though different foods and food-related services may fall into different classes, such as Applicant's and Opposer's, such foods and food-related services can be considered closely related for a likelihood of confusion analysis, especially when the foods and food-related services are complimentary.
- 25. Opposer's Goods and Services and Applicant's Goods should be considered closely related and complimentary, especially because Applicant's Goods, namely its breaded fish fillets, incorporate bread, which is a part of Opposer's Goods and Services.
- 26. Moreover, Applicant has already produced and sold products that incorporate bread and bakery products similar or the same as Opposer's Goods and Services under the same marks that comprise Applicant's Marks alongside and separate from Applicant's Goods, such as tempura batter mix, muffins, cakes and cookies. This shows that Applicant has already expanded into Opposer's Goods and Services, which would cause people to be confused as to source between Opposer and Applicant. Were Applicant to release further bread and bakery products under Applicant's Marks, this likelihood of confusion would continue, due to Applicant's expansion into Opposer's Goods and Services.
- 27. The consolidation and diversification of food manufacturing companies often leads to different types of food products being distributed by one company, with most consumers not being aware of this. Thus, when viewing Applicant's Marks in connection with Applicant's Goods, consumers are likely to be confused into believing that such goods originate with, are approved, sponsored or endorsed by, or have some connection or affiliation with Opposer.
- 28. Moreover, Opposer's Goods and Services and Applicant's Goods are complimentary because Opposer's bakery products and Applicant's fish products are often combined for dishes such as sandwiches.
- 29. Opposer's Goods and Applicant's Goods have similar trade channels because they both incorporate products that are found in the same places.

- Opposer's Goods and Applicant's Goods are offered to similar or 30. overlapping classes of purchasers.
- 31. Applicant's Marks, when used in connection with Applicant's Goods and Applicant's bread and bakery products is likely to cause confusion, to cause mistake, and to deceive the trade and public, who, upon seeing the Applicant's Marks in connection with Applicant's Goods and Applicant's bread and bakery products, would believe that such goods originate with, are approved, sponsored or endorsed by, or have some connection or affiliation with Opposer. Accordingly, registration of Applicant's Marks would damage Opposer, and registration, therefore, should be refused pursuant to Section 2(d) of the Trademark Act.

SECOND GROUND FOR OPPOSITION:

MERE DESCRIPTIVENESS - ONLY FOR APPLICATION SERIAL NO. 86/139,577



- 32. Opposer incorporates by reference Paragraphs 1 through 31 inclusive, as if fully set forth herein.
- 33. Applicant's Serial No. 86/139,577 incorporates as part of its design element the picture of a fish.
 - 34. Such a picture of a fish does not have secondary meaning.
- 35. Applicant's Goods are fish products such as: "GEFILTE FISH, FRESH FISH, NOT LIVE, FROZEN FISH, CANNED TUNA FISH, AND BREADED FISH FILLETS", as listed in the applications for Applicant's Marks.
- 36. The legally equivalent wording to the picture of a fish part of the design component of Applicant's Serial No. 86/139,577 is "fish".
- 37. Thus, the picture of a fish part of the design component of Applicant's Serial No. 86/139,577 is merely descriptive of Applicant's Goods. registration of Serial No. 86/139,577, should be refused pursuant to Section 2(e)(1) of the Trademark Act.

Wherefore, Opposer prays that this Opposition be sustained and that Application Serial No. 86/139,432 and Application Serial No. 86/139,577 be refused registration.

The required fee of six hundred dollars (\$600) has been previously submitted.

Respectfully Submitted,

/Steven A. Freund/

Dated: November 28, 2015 By: _____

Steven A. Freund, Esq. Attorney for Opposer Law Office of Steven A. Freund A Professional Corporation P.O. Box 911457 Los Angeles, CA 90091

Phone: 310-284-7929

EXHIBIT A

United States of America United States Patent and Trademark Office



Reg. No. 4,304,304 OAKHURST INDUSTRIES, INC. (CALIFORNIA CORPORATION), DBA FREUND BAKING

Registered Mar. 19, 2013 P.O. BOX 911457

LOS ANGELES, CA 900911457

Int. Cl.: 30

FOR: BAKERY PRODUCTS, IN CLASS 30 (U.S. CL. 46).

TRADEMARK FIRST USE 1-1-1981; IN COMMERCE 1-1-1981.

PRINCIPAL REGISTER

THE MARK CONSISTS OF THE WORD "FREUND" IN WHITE, PLACED IN A BLUE BANNER. THE BANNER IS CENTERED ON A DOUBLE CIRCLE, THE INNER ELEMENT OF THE CIRCLE IN YELLOW AND THE OUTER ELEMENT OF THE CIRCLE IN RED. THE WORDS "SINCE 1856 AND BAKING CO." APPEAR IN YELLOW LETTERING AROUND THE OUTER CIRCLE. THIS DESIGN IS CONTAINED WITHIN A WHITE RECTANGLE WITH A THIN BLUE BORDER.

THE COLOR(S) WHITE, BLUE, YELLOW AND RED IS/ARE CLAIMED AS A FEATURE OF THE MARK.

SER. NO. 85-627,606, FILED 5-16-2012.

HENRY S. ZAK, EXAMINING ATTORNEY



July 10 to 1

Generated on: This page was generated by TSDR on 2014-09-24 11:38:53 EDT

Mark: SINCE 1856 FREUND BAKING CO.



US Serial Number: 85627606 Application Filing Date: May 16, 2012 US Registration Number: 4304304 Registration Date: Mar. 19, 2013

Filed as TEAS Plus: Yes Currently TEAS Plus: Yes

Register: Principal Mark Type: Trademark

Status: Registered. The registration date is used to determine when post-registration maintenance documents are due.

Status Date: Mar 19 2013 Publication Date: Jan. 01, 2013

Mark Information

Mark Literal Elements: SINCE 1856 FREUND BAKING CO.

Standard Character Claim: No

Mark Drawing Type: 3 - AN ILLUSTRATION DRAWING WHICH INCLUDES WORD(S)/ LETTER(S)/NUMBER(S)

Description of Mark: The mark consists of the word "FREUND" in white, placed in a blue banner. The banner is centered on a double circle, the inner

element of the circle in yellow and the outer element of the circle in red. The words "SINCE 1856 and BAKING CO." appear in yellow

lettering around the outer circle. This design is contained within a white rectangle with a thin blue border.

Color Drawing: Yes

Color(s) Claimed: The color(s) White, Blue, Yellow and Red is/are claimed as a feature of the mark.

Design Search Code(s): 24.09.07 - Advertising, banners; Banners

26.01.01 - Circles as carriers or as single line borders

26.11.02 - Plain single line rectangles; Rectangles (single line)

Goods and Services

Note: The following symbols indicate that the registrant/owner has amended the goods/services:

• Brackets [..] indicate deleted goods/services;

Double parenthesis ((..)) identify any goods/services not claimed in a Section 15 affidavit of incontestability; and
 Asterisks *..* identify additional (new) wording in the goods/services.

For: Bakery products

International Class(es): 030 - Primary Class U.S Class(es): 046

> Class Status: ACTIVE Basis: 1(a)

> > First Use: Jan. 01, 1981 Use in Commerce: Jan. 01, 1981

Basis Information (Case Level)

Filed Use: Yes Currently Use: Yes Amended Use: No Filed ITU: No Currently ITU: No Amended ITU: No Filed 44D: No Currently 44D: No Amended 44D: No Filed 44E: No Currently 44E: No Amended 44E: No

Filed 66A: No Currently 66A: No Currently No Basis: No Filed No Basis: No

Current Owner(s) Information

Owner Name: Oakhurst Industries, Inc. DBA, AKA, Formerly: DBA Freund Baking Co.

Owner Address: P.O. Box 911457

Los Angeles, CALIFORNIA 900911457

UNITED STATES

Attorney/Correspondence Information

Attorney of Record

Attorney Name: Steven A. Freund, Esq.

Attorney Email No Authorized: Attorney Primary Email sfreund@freundlawfirm.com Address:

Correspondent

Correspondent STEVEN A. FREUND, ESQ.

Name/Address: LAW OFFICE OF STEVEN A. FREUND, A PROFESSIONAL COR

1801 CENTURY PARK E STE 2300

LOS ANGELES, CALIFORNIA 90067-2325

UNITED STATES Phone: 310-284-7929

 $\textbf{Correspondent e-mail:} \ \ \underline{ sfreund@freundlawfirm.com } \underline{ npgesq@aol.com}$

Correspondent e-mail Yes Authorized:

Domestic Representative - Not Found

Prosecution History

Date	Description	Proceeding Number
Mar. 19, 2013	REGISTERED-PRINCIPAL REGISTER	
Jan. 01, 2013	OFFICIAL GAZETTE PUBLICATION CONFIRMATION E-MAILED	
Jan. 01, 2013	PUBLISHED FOR OPPOSITION	
Dec. 12, 2012	NOTIFICATION OF NOTICE OF PUBLICATION E-MAILED	
Nov. 29, 2012	LAW OFFICE PUBLICATION REVIEW COMPLETED	68123
Nov. 27, 2012	APPROVED FOR PUB - PRINCIPAL REGISTER	
Nov. 27, 2012	TEAS/EMAIL CORRESPONDENCE ENTERED	68123
Nov. 27, 2012	CORRESPONDENCE RECEIVED IN LAW OFFICE	68123
Nov. 13, 2012	ASSIGNED TO LIE	68123
Oct. 22, 2012	TEAS RESPONSE TO OFFICE ACTION RECEIVED	
Oct. 17, 2012	NOTIFICATION OF PRIORITY ACTION E-MAILED	6326
Oct. 17, 2012	PRIORITY ACTION E-MAILED	6326
Oct. 17, 2012	PRIORITY ACTION WRITTEN	62126
Oct. 05, 2012	TEAS/EMAIL CORRESPONDENCE ENTERED	88889
Oct. 04, 2012	CORRESPONDENCE RECEIVED IN LAW OFFICE	88889
Oct. 04, 2012	TEAS RESPONSE TO OFFICE ACTION RECEIVED	
Sep. 12, 2012	NOTIFICATION OF NON-FINAL ACTION E-MAILED	6325
Sep. 12, 2012	NON-FINAL ACTION E-MAILED	6325
Sep. 12, 2012	NON-FINAL ACTION WRITTEN	62126
Sep. 06, 2012	ASSIGNED TO EXAMINER	62126
May 23, 2012	NOTICE OF DESIGN SEARCH CODE MAILED	
May 22, 2012	NEW APPLICATION OFFICE SUPPLIED DATA ENTERED IN TRAM	
May 19, 2012	NEW APPLICATION ENTERED IN TRAM	

TM Staff and Location Information

TM Staff Information - None File Location

Current Location: PUBLICATION AND ISSUE SECTION Date in Location: Mar. 19, 2013

Anited States of America United States Patent and Trademark Office



Reg. No. 4,500,792 OAKHURST INDUSTRIES, INC. (CALIFORNIA CORPORATION), DBA FREUND BAKING

CO.

Registered Mar. 25, 2014 P.O. BOX 911457

Int. Cl.: 40

LOS ANGELES, CA 900911457

FOR: PRIVATE LABEL BAKING SERVICES, IN CLASS 40 (U.S. CLS. 100, 103 AND 106).

SERVICE MARK FIRST USE 1-1-1981; IN COMMERCE 1-1-1994.

PRINCIPAL REGISTER OWNER OF U.S. REG. NO. 4,304,304.

> THE COLOR(S) WHITE, BLUE, YELLOW AND RED IS/ARE CLAIMED AS A FEATURE OF THE MARK.

> NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE "SINCE 1856" AND "BAKING CO.", APART FROM THE MARK AS SHOWN.

> THE MARK CONSISTS OF THE WORD "FREUND" IN WHITE, PLACED IN A BLUE BANNER. THE BANNER IS CENTERED ON A DOUBLE CIRCLE, THE INNER ELEMENT OF THE CIRCLE IN YELLOW AND THE OUTER ELEMENT OF THE CIRCLE IN RED. THE WORDS "SINCE 1856" AND "BAKING CO." APPEAR IN YELLOW LETTERING AROUND THE OUTER CIRCLE. THIS DESIGN IS CONTAINED WITHIN A WHITE RECTANGLE WITH A

THIN BLUE BORDER.

SER. NO. 85-946,497, FILED 5-30-2013.

TINA BROWN, EXAMINING ATTORNEY

Michelle K. Zen **Deputy Director of the United States**

Patent and Trademark Office

Generated on: This page was generated by TSDR on 2014-09-24 11:39:35 EDT

Mark: SINCE 1856 FREUND BAKING CO.



US Serial Number: 85946497 Application Filing Date: May 30, 2013 US Registration Number: 4500792 Registration Date: Mar. 25, 2014

> Register: Principal Mark Type: Service Mark

> > Status: Registered. The registration date is used to determine when post-registration maintenance documents are due.

Status Date: Mar. 25, 2014 Publication Date: Jan 07 2014

Mark Information

Mark Literal Elements: SINCE 1856 FREUND BAKING CO.

Standard Character Claim: No

Mark Drawing Type: 3 - AN ILLUSTRATION DRAWING WHICH INCLUDES WORD(S)/ LETTER(S)/NUMBER(S)

Description of Mark: The mark consists of the word "FREUND" in white, placed in a blue banner. The banner is centered on a double circle, the inner

element of the circle in yellow and the outer element of the circle in red. The words "SINCE 1856" and "BAKING CO." appear in yellow

lettering around the outer circle. This design is contained within a white rectangle with a thin blue border.

Color Drawing: Yes

Color(s) Claimed: The color(s) white, blue, yellow and red is/are claimed as a feature of the mark.

Disclaimer: "SINCE 1856" AND "BAKING CO."

Design Search Code(s): 24.09.07 - Advertising, banners; Banners

26.01.20 - Circles within a circle

26.01.21 - Circles that are totally or partially shaded.

26.11.01 - Rectangles as carriers or rectangles as single or multiple line borders

26.13.21 - Quadrilaterals that are completely or partially shaded

Related Properties Information

Claimed Ownership of US 4304304 Registrations:

Goods and Services

Note: The following symbols indicate that the registrant/owner has amended the goods/services:

Brackets [..] indicate deleted goods/services;

Double parenthesis ((..)) identify any goods/services not claimed in a Section 15 affidavit of incontestability; and
 Asterisks *..* identify additional (new) wording in the goods/services.

For: Private label baking services

International Class(es): 040 - Primary Class U.S Class(es): 100, 103, 106

Class Status: ACTIVE Basis: 1(a)

> First Use: Jan. 01, 1981 Use in Commerce: Jan. 01, 1994

Basis Information (Case Level)

Filed Use: Yes Currently Use: Yes Amended Use: No Filed ITU: No Amended ITU: No Currently ITU: No Filed 44D: No Currently 44D: No Amended 44D: No Filed 44E: No Currently 44E: No Amended 44E: No

Filed 66A: No Currently 66A: No Filed No Basis: No Currently No Basis: No

Current Owner(s) Information

Owner Name: Oakhurst Industries, Inc. DBA, AKA, Formerly: DBA Freund Baking Co.

Owner Address: P.O. Box 911457

Los Angeles, CALIFORNIA 900911457 UNITED STATES

Legal Entity Type: CORPORATION State or Country Where CALIFORNIA

Organized:

Attorney/Correspondence Information

Attorney of Record

Attorney Name: Steven Freund

Attorney Primary Email sfreund@freundlawfirm.com Attorney Email Yes Address: Authorized:

Correspondent

Correspondent STEVEN FREUND

Name/Address: LAW OFFICES OF STEVEN FREUND

PO BOX 911457

LOS ANGELES, CALIFORNIA 90091-1238

UNITED STATES Phone: 310-284-7929

Correspondent e-mail: sfreund@freundlawfirm.com npgesq@aol.com

Correspondent e-mail Yes Authorized:

Domestic Representative - Not Found

Prosecution History

Date	Description	Proceeding Number
Mar. 25, 2014	REGISTERED-PRINCIPAL REGISTER	
Jan. 07, 2014	OFFICIAL GAZETTE PUBLICATION CONFIRMATION E-MAILED	
Jan. 07, 2014	PUBLISHED FOR OPPOSITION	
Dec. 18, 2013	NOTIFICATION OF NOTICE OF PUBLICATION E-MAILED	
Dec. 05, 2013	LAW OFFICE PUBLICATION REVIEW COMPLETED	70884
Dec. 03, 2013	ASSIGNED TO LIE	70884
Nov. 07, 2013	APPROVED FOR PUB - PRINCIPAL REGISTER	
Nov. 05, 2013	TEAS/EMAIL CORRESPONDENCE ENTERED	88889
Nov. 04, 2013	CORRESPONDENCE RECEIVED IN LAW OFFICE	88889
Nov. 04, 2013	TEAS RESPONSE TO OFFICE ACTION RECEIVED	
Sep. 14, 2013	NOTIFICATION OF NON-FINAL ACTION E-MAILED	6325
Sep. 14, 2013	NON-FINAL ACTION E-MAILED	6325
Sep. 14, 2013	NON-FINAL ACTION WRITTEN	81858
Sep. 13, 2013	ASSIGNED TO EXAMINER	81858
Jun. 11, 2013	NOTICE OF DESIGN SEARCH CODE E-MAILED	
Jun. 10, 2013	NEW APPLICATION OFFICE SUPPLIED DATA ENTERED IN TRAM	
Jun. 03, 2013	NEW APPLICATION ENTERED IN TRAM	

TM Staff and Location Information

TM Staff Information - None File Location

Current Location: PUBLICATION AND ISSUE SECTION Date in Location: Mar. 25, 2014